

REMARKS / ARGUMENTS

The present application includes pending claims 1-30, all of which have been rejected. By this Amendment, claims 1, 11, and 21 have been amended, as set forth above, to further clarify the language used in these claims and to further prosecution of the present application. Support for the above amendments may be found in, for example, ¶ 47-48 and FIG. 3 of the present application. The Applicant respectfully submits that the claims define patentable subject matter.

Claims 1-4, 8-14, 18-24 and 28-30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over US Patent No. 6,947,768, issued to Adachi, et al. (hereinafter, Adachi), in view of U.S. Patent No. 5,640,678, issued to Ishikawa (hereinafter, Ishikawa), and further in view of U.S. Patent No. 6,216,002, issued to Holmring (hereinafter, Holmring). Claims 5-7, 15-17 and 25-27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Adachi, in view of Ishikawa and Holmring, and further in view of U.S. Patent Publication No. 2002/0077151, issued to Matthews, et al. (hereinafter, Matthews). The Applicant respectfully traverses these rejections at least based on the following remarks.

I. REJECTION UNDER 35 U.S.C. § 103

In order for a *prima facie* case of obviousness to be established, the Manual of Patent Examining Procedure (“MPEP”) states the following:

First, there must be some suggestion or motivation, either in the

references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the teaching. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

See MPEP at § 2142, citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (emphasis added). Further, MPEP § 2143.01 states that “the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art suggests the desirability of the combination,” and that “although a prior art device ‘may be capable of being modified to run the way the apparatus is claimed, there must be a *suggestion or motivation in the reference to do so*’” (citing *In re Mills*, 916 F.2d 680, 16 USPQ 2d 1430 (Fed. Cir. 1990)). Moreover, MPEP § 2143.01 also states that the level of ordinary skill in the art cannot be relied upon to provide the suggestion...,” citing *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ 2d 1161 (Fed. Cir. 1999). Additionally, if a *prima facie* case of obviousness is not established, the Applicant is under no obligation to submit evidence of nonobviousness.

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

See MPEP at § 2142.

A. Rejection of Claim 1

Claims 1-4, 8-14, 18-24 and 28-30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Adachi, in view of Ishikawa and Holmring. With regard to the rejection of independent claim 1 under 35 U.S.C. § 103(a), the Applicant submits that the combination of Adachi, Ishikawa, and Holmring does not disclose or suggest at least the limitation of “wherein each of said at least one of said plurality of access devices generates and maintains a handoff candidate list on its own without being prompted to do so by another device,” as recited by the Applicant in independent claim 1.

The Examiner states the following in the Office Action:

Adachi, in view of Ishikawa teaches all of the subject matter of the claimed invention except wherein the at least one of the plurality of access devices maintains a handoff candidate list and wherein the second wireless access point is selected from the handoff candidate list. Holmring from the same or similar fields of endeavor teaches wherein the at least one of the plurality of access devices maintains a handoff candidate list (see column 3 lines 22-41, the mobile has a handover candidate list) and wherein the second wireless access point is selected from the handoff candidate list (see column 3 lines 22-41, the list can be used to determine the optimal base station from the parameters in the list to handoff to).

See the Office Action at page 4. The Examiner conceded that the combination of Adachi-Ishikawa does not disclose “wherein the at least one of the plurality of access devices maintains a handoff candidate list and wherein the second wireless access point is selected from the handoff candidate list.” The Examiner then seeks support in the following citation of Holmring:

In this illustration, mobile station 150 is located in cell 76, for which BTS 56 is the "serving" BTS; that is, mobile station 150 is in radio communication with and under the control of BTS 56. **One of the communications control functions performed by a serving BTS is to cause mobile station 150 to develop a handover candidate list.** When

mobile station 150 is powered on in cell 74, or when mobile station 150 is handed over to BTS 56, the handover candidate list is initially empty. BSC 32 sends to mobile station 150, via BTS 56, identifications of BTS's from which mobile station 150 may receive radio signals. BTS's with signal quality above certain thresholds are placed on the handover candidate list, rank ordered from most suitable BTS (best quality signal measured by mobile station 150) to least suitable BTS (poorest quality signal, but still a potential handover candidate). Mobile station 150 periodically checks the signal quality of BTS's on the handover candidate list, updates it and reorders it according to the results of the measurements (emphasis added).

See Holmring at col. 3, lines 22-41. In the above citation, Holmring discloses that **the serving BTS causes the mobile station to develop the handover candidate list.**

More specifically, when a mobile station 150 is handed over to BTS 56, the handover candidate list is empty. Subsequently, the base station controller (BSC) 32 sends via the BTS 56, identifications of the BTS's from which the mobile station 150 may receive signals. The identification of these BTS's are then used for placing on the handover candidate list. In this regard, **the mobile station 150 does not generate and maintain a handoff candidate list on its own, without being prompted to do so by another device.** Adachi and Ishikawa do not overcome the above deficiency of Holmring.

Therefore, the Applicant maintains that the combination of Adachi and Ishikawa does not disclose or suggest at least the limitation of "wherein each of said at least one of said plurality of access devices generates and maintains a handoff candidate list on its own without being prompted to do so by another device," as recited by the Applicant in independent claim 1. Accordingly, the proposed combination of Adachi and Ishikawa does not render independent claim 1 unpatentable, and a *prima facie* case of

obviousness has not been established. The Applicant submits that claim 1 is allowable. Independent claims 11 and 21 are similar in many respects to the method disclosed in independent claim 1. Therefore, the Applicant submits that independent claims 11 and 21 are also allowable over the references cited in the Office Action at least for the reasons stated above with regard to claim 1.

B. Rejection of Dependent Claims 2-4, 8-10, 12-14, 18-20, 22-24, and 28-30

Based on at least the foregoing, the Applicant believes the rejection of independent claims 1, 11, and 21 under 35 U.S.C. § 103(a) as being anticipated by Adachi in view of Ishikawa and Holmring has been overcome and request that the rejection be withdrawn. Additionally, claims 2-4 and 8-10, 12-14 and 18-20, and 22-24 and 28-30 depend from independent claims 1, 11, and 21, respectively, and are, consequently, also respectfully submitted to be allowable.

The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 1-4, 8-14, 18-24, and 28-30.

C. Rejection of Dependent Claims 5-7, 15-17, and 25-27

Based on at least the foregoing, the Applicant believes the rejection of independent claims 1, 11, and 21 under 35 U.S.C. § 103(a) as being anticipated by Adachi in view of Ishikawa and Holmring has been overcome and request that the

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rejection be withdrawn. Additionally, since the additional cited reference (Matthews) does not overcome the deficiencies of Adachi, Ishikawa, and Holmring, claims 5-7, 15-17, and 25-27 depend from independent claims 1, 11, and 21, respectively, and are, consequently, also respectfully submitted to be allowable.

The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 5-7, 15-17, and 25-27.

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CONCLUSION

Based on at least the foregoing, the Applicant believes that all claims 1-30 are in condition for allowance. If the Examiner disagrees, the Applicant respectfully requests a telephone interview, and request that the Examiner telephone the undersigned Attorney at (312) 775-8176.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to the deposit account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

A Notice of Allowability is courteously solicited.

Respectfully submitted,

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